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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,426	03/31/2004	Lilian Alcaraz	056291-5103-01	3791
9629	7590	02/23/2006	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			NOLAN, JASON MICHAEL	
			ART UNIT	PAPER NUMBER

1626

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Claims 1-4, 6, 10-13, and 20-22 are currently pending in the application.

Priority

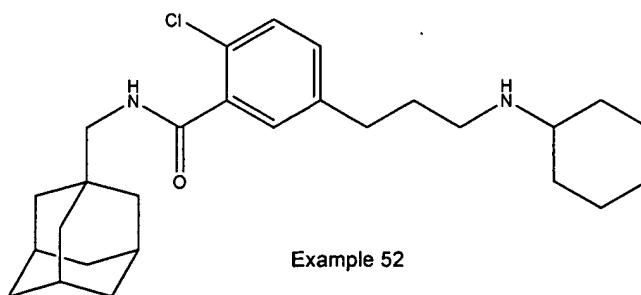
This application is a CON of 10/149,549, filed on 6/12/2002 and now US Patent 6,881,754, which is a 371 of PCT/SE00/02505, filed on 12/12/2000. Acknowledgement is made of Applicant's claim for foreign priority via Sweden 9904651-8, filed on 12/17/1999, United Kingdom 0015744.6, filed on 6/27/2000, and United Kingdom 0017942.4, filed on 7/22/2000.

Information Disclosure Statement

Applicant's information disclosure statements (IDS), filed on March 31, 2004 have been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

Response to Restriction

Applicant's election without traverse of **Group I, Claims 1-4, 6, 10 and 12**, drawn to compounds and compositions of the formula I is acknowledged. Applicant's election of the compound of the specification Example 52, 2-chloro-5-[3-(cyclohexylamino)propyl]-N-(tricyclo[3.3.1.1^{3,7}]dec-1-ylmethyl)-benzamide, shown below, is acknowledged.



Art Unit: 1626

Group II, Claims 20-22, drawn to methods of using the compounds according to the formula in Claim 1 and **Group III, Claims 11 and 13**, drawn to methods of making the compounds according to the formula in Claim 1, are currently withdrawn from consideration.

As previously stated in the restriction requirement, in accordance with M.P.E.P. 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of method of use claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until such time, a restriction between product claims and process is deemed proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

Art Unit: 1626

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6, 10 and 12 are rejected on the ground of nonstatutory double patenting over **Claims 1-5, 10, and 26** of U. S. Patent No. 6,881,754 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The scope of the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: **Claim 1** of the instant application is a sub-genus of **Claim 1** in the patent, and therefore, all limitations of the current application are supported by the parent US Patent. Additionally, **Claims 2-4, 6 and 12** are relatively identical to **Claims 2-5 and 26** of the patent. Furthermore, there are several overlapping species in **Claim 10** of the instant application and **Claim 10** of the patent. For example, the elected species is located in column 65, line 56.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM).

Art Unit: 1626

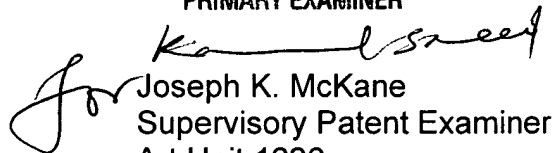
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason M. Nolan, Ph.D.
Examiner
Art Unit 1626

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER



for Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626

Date: February 3, 2006